

## REMARKS

Claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 stand rejected and remain pending. Claims 2-4, 6, 9, 13-16, 19, and 22-27 were canceled in previous responses. No claims are amended herein. The Applicant respectfully traverses the rejections and requests allowance of claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21.

### *35 U.S.C. § 112 Rejection*

Claims 1 and 12 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. The final Office action indicates that the clause “wherein the insertion point comprises data indicating where in the selected video content the selected video advertising is to be inserted” was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed (final Office action, page 2). The final Office action asserts that an insertion point which includes data, as provided in the clause above, was not described in the specification. The final Office action asserts that the point in the video content where the advertisement is to be inserted is “different than the insertion point including data which indicated where the advertising is to be inserted” (final Office action, page 3).

The Applicant respectfully asserts that the clause of claim 1 referenced above has adequate support in the specification to reasonably convey the claimed invention to one skilled in the art. In the context of this application, the plain meaning of “insertion point” is the *point* in the playback of the video content data at which something is to be *inserted*. Since the video content is in the form of a data stream, any insertion point which references a point within the data stream at which something is to be inserted would also have to exist in the form of data.

The specification states that “video-on-demand system 200 transfers the selected video content 201 over the transport system 202” while the insertion points are transferred “over either the transport system 202, *or* the transport system 204” (Application, page 6, lines 9-11, 16-17) (emphasis added). Because the insertion point can be transported *separately from* the video content, it cannot be an element of the video

content and must be a *reference to* a location within the video content. Therefore, the insertion point must inherently comprise data.

Further, Fig. 3 of the application indicates that insertion points (T1, T2, ..., TN) may be stored in viewer profile *data structure* 330 within processing system 211. (Specification, page 7, lines 5-9.) The insertion points must exist in the form of data in order to populate a data structure.

Therefore, in light of the discussion above, Applicant respectfully requests withdrawal of the 35 U.S.C. § 112 rejection of claims 1 and 12.

### *35 U.S.C. § 103 Rejection*

Claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,718,551 (hereinafter Swix) in view of U.S. Patent No. 6,698,020 (hereinafter Zigmond) in view of “NDS: NDS’ XTV™ Time Shifting Technology Empowers the Viewer and the Broadcaster,” M2 Presswire (Sept. 10, 1999) (hereinafter XTV), and further in view of U.S. Patent No. 6,588,015 (hereinafter “Eyer”).

The rejection is improper because the final Office action does not address a limitation of claim 1, “transferring the insertion point to the target viewer device over the second transport system.” This limitation is not discussed or identified within Swix, Zigmond, or the combination of Swix and Zigmond (see final Office action, pgs. 3-4). Although the final Office action later states “it would have been obvious to one of ordinary skill in the art at the time of the invention to transmit . . . the insertion point . . . to the set-top,” transferring the insertion point *over a second transport system which uses less bandwidth* than the first transport system is never addressed (final Office action, page 7).

Furthermore, this limitation of claim 1 is not obvious. Swix and Zigmond specifically teach away from “transferring the insertion point to the target viewer device over the second transport system” and neither discloses use of a lower bandwidth transport system for that purpose.

In Swix, the beginning of an insertion slot for a targeted advertisement is indicated by the head end using a “q-tone” (Swix, col. 13, lines 15-17). At the q-tone, the

head end communicates to “each set-top box 1) which PID to tune to, and 2) for how long” (Swix, col. 13, lines 24-28). The set-top box, or target viewer device, receives no information referencing a *location* in the video content where the advertisement will be inserted; it simply receives a *real time command* to immediately change to another channel. Swix also teaches that the *head end* manages the advertisement insertion process for all set-top boxes and is responsible for *real time* communication to each set-top box each time tuning to a different channel is required (Swix, col. 13, lines 24-33). Thus, the insertion point is not *transferred* to the target viewer device *over a second transport system* as recited in claim 1 and doing so would be illogical within the real time operation of the Swix system.

Combining Zigmond with Swix does not overcome this limitation nor make it obvious. In Zigmond, the home entertainment system does not receive information about where advertisements will be inserted relative to the video content. Like Swix, the entertainment system of Zigmond simply waits for a trigger signal and *immediately* switches to a different video source *in response to that trigger signal* without any reference to how that switch relates to the video content (Zigmond, Fig. 6). Thus, the insertion point is not *transferred* to the target viewer device over a second transport system as recited in claim 1.

XTV and Eyer relate generally to methods of prohibiting viewers from skipping advertisements and do not address the limitations of claim 1 discussed above.

Independent claim 12 contains limitations similar to those described above with respect to claim 1, and is therefore respectfully asserted to be allowable over the art of record for the same reasons as claim 1.

Therefore, for at least the reasons discussed above, Applicant contends that independent claims 1 and 12 are allowable in view of the combination of Swix, Zigmond, XTV, and Eyer, and such indication is respectfully requested.

Dependent claims 5, 7, 8, 10, and 11 depend from independent claim 1, and claims 17, 18, 20, and 21 depend from independent claim 12. Therefore, dependent claims 5, 7, 8, 10, 11, 17, 18, 20, and 21 are allowable for at least the same reasons discussed with respect to claims 1 and 12.

In view of the foregoing discussion, the Appellant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21.

### **CONCLUSION**

Based on the remarks above, the Applicant respectfully submits that claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 are allowable in their present form and such indication is respectfully requested.

The Applicant believes no fees are due with respect to this filing. However, should the Office determine fees are necessary, the Office is hereby authorized to charge Deposit Account No. 21-0765 accordingly.

Respectfully submitted,

/Todd C. Adelmann/

**SIGNATURE OF PRACTITIONER**

Todd C. Adelmann, Reg. No. 55,827

Setter Roche LLP

Telephone: (720) 562-2280

E-mail: todd@setterroche.com

**Correspondence address:**

**CUSTOMER NO. 28004**

Attn: Melissa A. Jobe

Sprint

6391 Sprint Parkway

Mailstop: KSOPHT0101-Z2100

Overland Park, KS 66251-2100